

REMARKS

This paper is filed in response to the final office action mailed on August 11, 2004. Claim 1 has been amended; claims 1-9 are pending.

In the final office action, claims 1-4 and 6-9 stand rejected under 35 U.S.C. § 103 as being unpatentable over the combination of four different references; U.S. Patent No. 5,594,806 ("Colbert"); U.S. Patent No. 6,142,876 ("Cumbers"); U.S. Patent No. 6,460,848 ("Soltys"); and U.S. Patent No. 5,386,103 ("DeBan").

In response, a clarifying amendment has been made to claim 1 and applicants respectfully submit that the obviousness rejection does not meet the standards of MPEP §§ 2142 and 2143 for the following reasons. Specifically, under MPEP §§ 2142 and 2143,

[t]o establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure.

Citing, In re Vaeck, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991); *see also* MPEP § 2143-§ 2143.03 for decisions pertinent to each of these criteria.

Applicants respectfully submit that the obviousness rejection of claims 1-4 and 6-9 is improper for it fails to establish a *prima facie* case of obviousness for at least two reasons. First, the proposed hypothetical combination does not teach or suggest all the claim limitations of amended claim 1 and there is no motivation or suggestion either in the references themselves or in the knowledge generally available to one of ordinary skill in the art to modify the references, without using applicants' disclosure as a template. In short, applicants respectfully submit that the Patent Office is using impermissible hindsight. *In re Rouffet*, 47 USPQ2d 1453, 1457-58 (Fed. Cir. 1998).

At the outset, amended claim 1 requires the generating of a first facial image information regarding a person and storing that information on a card. Claim 1 then requires the reading of that card and the first facial image information at a gaming machine in a casino. Claim 1 also requires the obtaining of current facial image information at the gaming

machine of a person using that card. The hardware of the gaming machine then compares the first facial image information and the current facial image information at the machine and in the casino to confirm the person using the card is the party entitled to use the card.

The base reference, Colbert, is not directed toward gaming machines at all but, instead, is directed toward a security system that uses a knuckle profile. Thus, Colbert is clearly deficient as a base reference as it really has no applicability to gaming machines or facial image information.

In an attempt to supplement Colbert, the Patent Office relies upon Cumbers. Cumbers does teach the use of facial images for security purposes but teaches nothing about the use of a card or the storing of facial image information on a card or the determination of whether the card being used at a machine (Cumbers does not teach or suggest the use of a card at a machine) for determining whether the person using the card at a machine is entitled to use that card. Thus, no combination of Colbert and Cumbers teaches or suggests numerous limitations of claim 1.

In an attempt to supplement Colbert and Cumbers, the Patent Office then relies upon Soltys. Soltys is directed toward methods for monitoring casinos and gaming in general. However, the Patent Office relies upon column 22 of Soltys which suggests the use of a "comp" card to establish player identity. The card disclosed in Soltys does have a magnetic stripe but nowhere in Soltys is it taught or suggested that facial image information be stored on a card and then used at a machine. Soltys merely teaches the use of a card that no storing of facial information on the card or the comparison of facial information stored on a card with current facial information taken at a machine. Soltys does not teach or suggest any comparison made at a machine. Thus, no combination of Colbert, Cumbers and Soltys teaches or suggests all of the limitations of amended claim 1.

Finally, the Patent Office relies on DeBan. DeBan is not directed toward gaming or gaming machines. DeBan is directed toward automatic teller machines. While DeBan discloses the use of magnetic cards at an ATM and the transmission of facial image information to a remote location where a comparison is made to an image on file, DeBan in no way teaches or suggests the recording of facial image information on a card and the comparison of facial information from that card to the currently viewed facial information at the ATM where the comparison is performed at the ATM. Without any comparison being

done at the ATM, DeBan cannot be modified to supplement the deficiencies of Colbert, Cumbers and Soltys as described above.

Therefore, no combination of these four references teaches or suggests all of the limitations of amended claim 1 and therefore no *prima facie* case of obviousness has been established. Further, applicants respectfully submit that the use of four disparate references, two of which have nothing to do with gaming or gaming machines, would render any reformulated obviousness rejection to be based on impermissible hindsight in violation of the provisions of the MPEP and the relevant case law.

Finally, the Patent Office rejects claim 5 under 35 U.S.C. § 103 as being unpatentable over Colbert, Cumbers, Soltys, DeBan and further in view of U.S. Patent No. 5,801,766 ("Alden"--applicants presume that the examiner is referring to this reference even though the Patent Office states "Allen '766"). However, Alden merely teaches the transformation of an analog signal to a digital signal, is not directed toward gaming machines or security at gaming machines and therefore is not cited for the proposition that it discloses any of the missing limitations described above. That is, Alden does not teach or suggest the recording of facial image information on a card, the reading of that facial image information on a card at a gaming machine in a casino and the comparison of facial image information generated at the casino using the camera or other suitable device with the facial image information recorded on the card at the gaming machine in a casino to verify that the person using the card is, indeed, the person whose facial information is recorded on the card. Therefore, Alden cannot supplement the four references cited above in an attempt to render claim 1 obvious.

Applicants respectfully submit that this amendment is in full compliance with Rule 116 because it raises no new issues, traverses the obviousness rejection and places this application clearly in a condition for allowance. An early action so indicating is respectfully requested.

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The Commissioner is authorized to charge any fee deficiency required by this paper, or credit any overpayment, to Deposit Account No. 13-2855.

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Respectfully submitted,

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